

II. REMARKS

A. Introduction

The Office Action dated February 13, 1997 has been carefully reviewed and the foregoing amendments made in response thereto.

Claims 2-53 stand rejected under 35 U.S.C. § 35 U.S.C. section 112 second paragraph. Claims 2, 4-7 and 9 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Hedger et al.. Claims 10 stands rejected under 35 U.S.C. § 102(e) as being anticipated by Pargee, Jr.. Claims 2-9, 11-14, 29-33, 39-42 and 45-49 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Zaboklicki. Claims 15 and 16 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Block et al.. Claim 17 stands rejected under 35 U.S.C. § 102(b) as being anticipated by Breeze. Claim 39 stands rejected under 35 U.S.C. § 102(b) as being anticipated by Zawels et al.. Claims 43 and 44 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Summers. Claims 34-38 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Zawels et al. (U.S. #3,606,688) in view of Zawels (DE 2,853,764). Claims 2-53 stand rejected under the judicially created doctrine of non-obviousness non-statutory double patenting over the patented claims in U.S. Patents 4,694,490; 4,704,725; 4,965,825; and 5,109,414.

Claims 2, 3, 5-9, 11-15, 18-29, 31, 32, 34, 37, 39-43, 45, 47-50, 52 and 53 have been amended. Claim 44 has been canceled. Claims 2-43, and 45-53 remain active in this application.

As to the paragraph numbered 2, applicants will address the art rejections of this Office Action. Applicants, however, traverse the assertion that a double patenting situation exists. The present application claims priority under 35 U.S.C. § 120 of the following applications:

<u>Serial No.</u>	<u>Filing Date</u>	<u>Patent No.</u>
08/113,329	August 30, 1993	Pending
08/056,501	May 3, 1993	5,335,277
07/849,226	March 10, 1992	5,233,654
07/588,126	September 25, 1990	5,109,414
07/096,096	September 11, 1987	4,965,825
06/829,531	February 14, 1986	4,704,725
06/317,510	November 3, 1981	4,694,490

As to the paragraph numbered 3, applicants acknowledge their duty to maintain a line of patentable demarcation between related applications. Assuming, arguendo, that substantially duplicate claims exist, the applicants intend to make a good faith effort to alert the PTO of any instances in which the PTO treats such claims inconsistently.

As to the paragraph numbered 4, applicants acknowledge and appreciate the examiner's concern over the use of alternative claim language. Applicants assert that they believe that the disclosure supports every possible embodiment or permutation that can be created using said language. During the prosecution of this application, applicants intend to ensure that the disclosure supports each possible embodiment or claimed using alternative claims.

As to the double patenting rejections, applicants' views are fully discussed in applicants' reply brief to the rejections in application number 08/113,329 which is herein incorporated by reference. Applicants also address this rejection in the present application.

As to the paragraph numbered 11, the Office Action states that "determination of a possible non-statutory double patenting rejection obvious-type in each of the related 327 applications over each other will be deferred until a later time." Applicants submit that the examiner and the PTO cannot defer further rejections to a later time. Every ground of rejection should be made in examiner's first Office Action. 37 CFR § 1.104(a)

states that “[o]n taking up an application for examination . . . the examiner shall make a thorough study thereof and shall make a thorough investigation of the available prior art relating to the subject matter of the claimed invention. The examination shall be complete with respect to both compliance of the application . . . with the applicable statutes and rules and to the patentability of the invention as claimed, as well as with respect to matters of form, unless otherwise indicated.” The MPEP states “[t]he examiner’s action will be complete as to all matters, except that in appropriate circumstances, such as misjoinder of invention, fundamental defects in the application, and the like, the action of the examiner may be limited to such matters before action is made.” MPEP § 707.07, citing 37 CFR § 1.105. Finally, “[p]iecemeal examination should be avoided as much as possible. The examiner ordinarily should reject each claim on all valid grounds available” “Where a major technical rejection is proper, it should be stated with full development of reasons rather than by mere conclusion coupled with some stereotyped expression.” MPEP § 707.07(g). Applicants submit that the examiner has a duty to give each application a complete examination, to make rejections with specificity, and that not to defer rejections. For these reasons, applicants likewise traverse the rejection based on the “judicially created doctrine of double patenting over the claims of copending U.S. application 08/113,329 and the following [list of all applicants copending applications].” Applicants submit that this rejection, even if appropriately made with specificity, should be a provisional double patenting rejection. Applicants respectfully request that this rejection be withdrawn.

As to the grouping of paragraphs numbered 36, applicants acknowledge and appreciate the interviews provided by the PTO. Applicants also appreciate the detailed description of the interviews provided in the Office Action. The Office Action states that “the Group would like to have a complete grouping of applications in a manner that was submitted earlier for only a portion of the total filings.” Applicants note that

based on the Office Actions received thus far, the PTO does not appear to be following the groupings applicants submitted previously. The order of examination of applicants' applications do not seem to have any correspondence to the groupings previously submitted. Applicants, therefore, will not supply further groupings. Applicants will, however, gladly supply further groupings if requested by the PTO for the purpose of following these groupings. Mr. Groody has confirmed in a telephone conversation between Mr. Groody and Mr. Scott that no more groupings need be sent.

In the interest of maintaining a clear record, applicants respectfully traverse the Office Action's interview summary statement that an offer was made to terminally disclaim the present application with the '81 or '87 patents. Rather, applicants respectfully submit that their offer was to disclaim a block of copending applications against one another, provided their issue date was in close enough proximity so as not to result in unnecessarily great losses in patent term duration.

B. Pending Claims in View of the Applied Art

1. 35 U.S.C. § 112 Rejections

a. General remarks

The Office Action rejects all claims in the present application under 35 U.S.C. section 112, second paragraph. The Office Action states that the "examiner is not certain that the meets [sic] and bounds of these claims can be determined because of the language in the disclosure and claims." It further states that "[a]pplicants are being requested to reference the claim limitations in this application to the disclosure so that the meets [sic] and bounds of these claims can be properly considered." Applicants traverse this rejection and submit that applicants have no duty to comply with this requirement. MPEP § 2111 states that "[d]uring patent examination, the pending claims must be 'given the broadest reasonable interpretation consistent with the

specification.’’ Also, it is only ‘when the specification provides definitions for terms appearing in the claims that the specification can be used in interpreting claim language.’’ MPEP § 2111.01. The examiner has the responsibility of reading the specification to determine the meaning of terms in the claims of the application.

However, in order to advance the prosecution of the present application, applicants shall provide a summary of the pertinent disclosure including reference to examples supporting the claimed subject matter. Applicants shall provide citations to the ‘81 case supporting the pending claims, as well as a cross-reference to corresponding sections of the ‘87 specification. The present application asserts priority on the disclosure of the ‘81 case, filed on November 3, 1981, application no. 317,510, and issued September 15, 1987, as U.S. Pat. No. 4,694,490. The disclosure of the ‘81 case is generally addressed to apparatus and methods for automatically controlling the transmission and presentation of information programming, including the application of embedded signaling for a number of functions, including the control over decryption and access, monitoring of usage/availability, control of external equipment, coordination of multiple broadcasts, automated compilation and collection of billing data, and generation and presentation of combined media presentations of broadcast and locally-generated user specific content. (U.S. Pat. No. 4,694,490, Abstract; col. 3 line 29 to col. 5 line 27). The priority disclosure further discusses coordination and control of programming at several levels of the communications chain, including transmission stations, intermediate transmission stations, and receiver stations.

Regarding the present application, the claims are generally supported in applicants’ U.S. Pat. No. 4,694,490, col. 4, line 31, col. 6, line 22 through col. 10, line 13, and col. 18, line 42 through col. 20, line 68¹.

¹ See also applicants’ 1987 specification, page 14, lines 26-35, pages 36-38, page 54, lines 4-8, pages 356-372, and pages 516-532.

Specifically, regarding claims 6 and 18, see especially applicants' U.S. Pat. No. 4,694,490, col. 10, line 14 through col. 12, line 67. Regarding claim 10, see especially applicants' U.S. Pat. No. 4,694,490, col. 19, line 30 through col. 20, line 10. Regarding claim 11, see especially applicants' U.S. Pat. No. 4,694,490, col. 20, lines 16-68. Regarding claim 15, see especially applicants' U.S. Pat. No. 4,694,490, col. 15, line 26 through col. 17, line 33. Regarding claim 17, see especially applicants' U.S. Pat. No. 4,694,490, col. 18, line 42 through col. 19, line 29. Regarding claim 21, see especially applicants' U.S. Pat. No. 4,694,490, col. 2, line 64 through col. 3, line 5, col. 7, lines 36-64, col. 8, lines 32-55, and col. 10, line 14 through col. 12, line 67. Regarding claims 26, 29, and 45, see especially applicants' U.S. Pat. No. 4,694,490, col. 20, lines 16-68, col. 10, line 14 through col. 12, line 67, and col. 15, line 26 through col. 17, line 33. Regarding claim 34, see especially applicants' U.S. Pat. No. 4,694,490, col. 19, lines 20-27, paragraph beginning at col. 4, line 5, and col. 11, lines 57-65². Regarding claim 39, see especially applicants' U.S. Pat. No. 4,694,490, col. 19, line 5 through col. 20, line 10. Regarding claim 43, see especially applicants' U.S. Pat. No. 4,694,490, col. 7, lines 60-64, and col. 19, line 5 through col. 20, line 10³. Regarding claim 50, see especially applicants' U.S. Pat. No. 4,694,490, col. 2, line 64 through col. 3, line 5, col. 7, lines 36-64, col. 8, lines 32-55, col. 10, line 14 through col. 12, line 67, and col. 20, lines 16-68.

Applicants provide these specific embodiments in support of the pending claims by way of example only. The claims must be read as broadly as is reasonable in light of the specification, and applicants in no way intend that their submission of excerpts/examples be construed to unnecessarily restrict the scope of the claimed

² See also applicants' 1987 specification, page 445, line 22 through page 446, line 23, page 346, line 34 through page 347, line 5, page 356, line 27 through page 357, line 20, and page 367, line 25 through page 372, line 35.

³ See also applicants' 1987 specification, page 31, lines 26-29.

subject matter. Applicants will provide additional specification support, as needed, in their detailed response to the Examiner's specific rejections provided infra.

b. Specific remarks

The Office Action questions the meaning of certain terms, and where certain terms are enabled in applicants' specification. The following is presented to help further prosecution and resolve the various questions raised regarding certain claim language terms. Applicants provide these specific embodiments in support of the pending claims by way of example only. The claims must be read as broadly as is reasonable in light of the specification, and Applicants in no way intend that their submission of excerpts/examples be construed to unnecessarily restrict the scope of the claimed subject matter.

Regarding "combined or sequential":

At column 19, line 30 to column 20, line 10, the coordination of multimedia presentations in time is disclosed. Therein, two types of graphics are described; studio generated graphics and microcomputer generated graphics. The microcomputer generated graphics are generated locally, at the microcomputer of the user station that employs the methods and apparatus of the present invention. They are disclosed as containing a user specific datum that is the user's own stocks' performance. During the transmission of the "Wall Street Week" mass medium program, a microcomputer generated graphic is overlaid the studio generated graphic. Column 19, line 59 to column 20, line 2. This is a "combined" presentation of a mass medium program and a user specific datum. After the microcomputer ceases transmitting the first microcomputer generated graphic, it prepares to send the a second microcomputer generated graphic for overlay upon the studio generated graphic. Column 20, line 2-7. The first and second microcomputer generated graphics are presented in sequence and

with a mass medium program. Accordingly, a sequential presentation of a mass medium program and a user specific datum is disclosed.

Regarding prompting; promoting:

"Prompting" support is found in U.S. Pat. No. 4,694,490 at column 20, lines 18-23, and corresponds to the '87 Specification at pp. 469-478, *see also* 463- 469 and 478-516.

Applicants would like to direct the Examiner's attention to the '81 disclosure, page 38, lines 7-15. The example states that "[s]ignal processor, 200, receives this instruction from microcomputer, 205, at its processor or monitor, 12, which reacts, in a predetermined fashion . . .". (U.S. Patent No. 4,694,490, col. 19, lines 12-20). *See also* U.S. Patent No. 4,694,490, col. 20, lines 16-68 (illustrating one method for coordinating the presentation of information through the use of print with video for a cooking-show recipe).

Applicants would also like to direct the Examiner's attention to the '87 disclosure, page 507, line 15 to page 508, line 34. The example illustrates a media transmission that promotes a particular product and prompts the user for an order. *See also* '87 disclosure, page 471, line 3 to page 472, line 12 (providing an example of a program devoted to the subject of cooking that promotes a recipe and prompts the user for response).

Regarding "analog and digital TV", and "separately defined"

In 1981, both analog television and digital television were well-known to those having ordinary skill in the art. From column 13, line 1 to column 14, line 62, the '81 case discloses the use of encryption to govern the reception of programming. Encryption is "a process for enciphering or encoding data to prevent illicit entry into a system." *Webster's II, New College Dictionary*, 1995. To encode is "to convert (a character) into an equivalent combination of bits." *Id.* Thus, encryption is a process for

converting data into an equivalent combination of digits to prevent illicit entry into a system. From column 13 , line 68 to column 14, line 4, the '81 case explicitly discloses that:

“A decrypter does not necessarily decrypt the entire transmission. Encrypted transmissions may be only partially encrypted. For example, only the video portion of the transmission may be encrypted. The audio portion may remain unencrypted.”

Since throughout the '81 case it is disclosed that programming transmissions may be of television, it is submitted that the cited passage discloses that television programming transmissions (i) include a video portion and an audio portion, and (ii) may be either entirely encrypted or partially encrypted. Since encrypting a television programming transmission involves “convert[ing] (a [television programming transmission]) into an equivalent combination of bits,” clearly the '81 case discloses “digital television.”

Further, the '81 case discloses that “[m]icrocomputer, 205, is preprogrammed to respond to . . . instruction signals embedded in the “Wall Street Week” program[m]ing transmission . . . [that] instruct microcomputer, 205, to generate several graphic video overlays.” (col. 19, lines 42-49). These instruction are embedded in *digital* form into the television programming (“Wall Street Week”) by *encoding* means (col. 9, lines 31-33). Thus, the television programming transmission is disclosed as containing embedded, encoded digital signals that generate television programming. The '81 case discloses the television programming transmission including digital signals and, thus, being “digital television.”

At column 6, lines 22- 68, column 7, lines 1-5, it is disclosed that a television programming transmission is received at the signal processor of Figure 1. A particular frequency of the television programming transmissions is selected and passed to the TV signal decoder of Figure 2A. At the TV signal decoder, the selected frequency of the programming transmission is then transmitted through paths A, B and C to three separate digital detector devices, 34, 37 and 38 ,that are designed to act on particular

frequency ranges in which *encoded* signal information may be found. Digital detector 34 decodes *encoded* signal information in the line portion or portions of the analog video portion of the television programming transmission. Likewise, digital detector 37 determines whether a particular encoded signal is present in the audio portion of the television programming transmission. Digital detector 38 receives a separately defined, and clearly digital, transmission. Since paths A and B carry the video and audio portions, of the television transmission, respectively, the separately defined portion is at least some of that which remains in the television programming transmission. Since the television programming transmission is disclosed to be comprised of a video portion, an audio portion and embedded encoded digital signals, the separately defined transmission is at least some of the television programming transmission that contains the encoded digital signals. Thus, it is disclosed that the audio portion, video portion and signal portion of the television programming transmission may be entirely or partially encoded in digital format, separately defined from analog format, thereby comprising "digital television."

Regarding "coordinate or instruct-to-coordinate":

The established meaning of the verb coordinate, as defined by *Webster's II New College Dictionary*, 1995, is, in transitive form, "1. To place in the same order, class, or rank. 2. To harmonize in a common effort," and, in intransitive form, "To work together harmoniously." In the '81 case, at column 19, line 30 to column 20, line 10, there is described "Co-ordinating Multimedia Presentations in Time" in which programming delivered at different times to a viewer can be co-ordinated to give a multimedia presentation at one time in one place. Therein, it is described that, at 4:30 PM, closing stock prices for the day are received by the viewer's microcomputer via a digital information channel. Stock prices that relate to stocks in a stored portfolio are recorded by the viewer's microcomputer. At 8:30 PM, the "Wall Street Week"

programming transmission begins. Thus, the programming delivered at different times to one place is the closing price information of the viewer's stock and the "Wall Street Week" transmission. The programming transmission contains instruction signals that are transferred to the microcomputer. The instruction signals (instruct-to-generate signals) instruct the microcomputer to generate a graphic video overlay that represents what the stocks in the viewer's stored portfolio did in the past week. After the "Wall Street Week" host says, in the programming transmission, "here is what your portfolio did," a whole multimedia presentation simultaneously comprised of a combination of the "Wall Street Week" transmission and the graphic video overlay is given at a TV set of the viewer. In order to coordinate the delivered programming to give the multimedia presentation, an instruction signal instructs the microcomputer to transmit the graphic video overlay for as long as it receives the same instruction signal. When the instruction signal is no longer received by the microcomputer, the microcomputer ceases transmitting the overlay to the TV set. Thus, the instruction signal coordinates the transmission of the overlay with the "Wall Street Week" programming transmission to give a multimedia presentation.

Regarding "product":

"Product" support is found in U.S. Pat. No. 4,694,490 at column 20, lines 21 & 50, and corresponds to the '87 Specification at pp. 469-478, *see also* 463- 469 and 478-516.

The established meaning of the term "product" is "something produced by human or mechanical effort or by a natural process." *Webster's II New College Dictionary*, 1995. The recipe from "The French Chef" television program is a product as per the established meaning of the term. Column 20, lines 20-21. A generated output that is associated with this product/recipe is the printed copy from printer 221. Column 20, lines 20-21 and 46-49.

Also, concerning the term "product", Applicants point to the passage of the '87 specification beginning on page 550, line 30, and recited throughout in other places, which discusses the type of crops that the farmer is growing, to be collectively called "product". That is to say, the crops that the individual farmers are growing, be it oats (page 550, line 33), wheat (*ib.*, line 34), broad beans (page 551, line 1), tomatoes (page 551, line 2), red tulips (*ib.*, line 4), or blue tulips (*ib.*, line 5), are in essence "product" in terms of Applicants' inventive method.

Regarding "query":

The term "query" is found in the '81 specification, within the following passage:

"Each weekday, microcomputer, 205, receives, about 4:30 PM, by means of a digital information channel, all closing stock prices applicable that day. It may receive these directly or it may automatically *query* a data service for them in a predetermined fashion." '81 case, column 19, lines 35-41, emphasis added.

Thus, it is disclosed that a microcomputer may query a data service for closing stock prices. In this context, the core meaning of the noun "query" and its listed synonyms given by *Webster's II New College Dictionary*, 1995 is most appropriate. That meaning is "a request for data." *Id.* at page 908. "Query" is also defined as a noun that means "a request for information" and as a verb that means "to mark with a query." *Id.* Accordingly, what the cited passage essentially discloses is that a microcomputer may request, or query, data or information from a data service. Accordingly, an operational embodiment of the present inventions using the established meaning of the term "query" is disclosed.

Additionally, it is disclosed elsewhere in the '81 case that a signal processor can "operate in a predetermined fashion and telephone a remote site to get an additional

signal or signals for the proper decryption and/or transfer of incoming programming [sic] transmissions." Column 15, lines 20-25. The telephoning of the remote site to get the additional signal amounts, essentially, to a request, or query, for an additional signal. Such a telephoning of a remote site may be accomplished by way of a control signal that is an instruction for the apparatus of the present invention to contact a remote telephone unit. Column 8, lines 56 to 65. Thus, the '81 case contemplated using a control signal to instruct telephoning of a remote site in order to query the remote site for additional signals. It also disclosed that an incoming program transmission can include a signal that instructs a tuner of a user station to tune to an appropriate channel to receive information that supplements television programming. Column 20, lines 27-37. The tuning to the appropriate channel in order to receive the information is, essentially, a request, or query, for the information. Thus, the '81 case contemplated using a signal to effect a user station to receive supplemental program material.

Applicants respectfully submit that the specification adequately describes and fully enables the use of the term "query" in the claims as per its ordinary usage and that claim 9 is adequately described and fully enabled by the specification, and sufficiently definite to allow one of ordinary skill in the art to comprehend the bounds of the claimed subject matter. With regards to the term "query," Applicants respectfully submit that the objection to the specification under 35 U.S.C. §112, first paragraph, and the rejection of claim 9 under 35 U.S.C. §112, first paragraph, be withdrawn.

Regarding "reaction", "react", and "instruct-to-react":

"React" support is found in U.S. Pat. No. 4,694,490 at column 20, lines 23-24, and corresponds to the '87 Specification at pp. 469-478, *see also* 463-469 and 478-516.

At column 19, line 42-68, an operational embodiment is described wherein a station using the signal processor apparatus and methods of the present invention is equipped with a microcomputer that "is preprogrammed to respond in a predetermined fashion to instruction signals embedded in" a programming transmission of "Wall Street Week." The preprogrammed response of the user station's microcomputer to the embedded signals is a "reaction," as per the term's established meaning.

Another instance of '81 specification support for the term "reaction" is found at column 18, line 43 to column 19, line 4. Therein is described a method for monitoring multiple programming channels and selecting programming and information in a predetermined fashion. In this example, a microprocessor of a station using the signal processor apparatus and methods of the present invention is programmed to hold a portfolio of stocks and to receive news about these stocks. News is transmitted on different channels to a converter box and a signal processor of the user station. Each news transmission is preceded with a unique signal. In a predetermined fashion, the microcomputer instructs the signal processor to hold examples of unique signals that are sought after and compare them with all of the incoming unique signals of the news transmissions. When the signal processor identifies a sought for unique signal via the comparison, it relays information of that signal to the microcomputer. Then, in a predetermined fashion, either the microcomputer or the signal processor instructs a

tuner to set the converter box to the proper channel. The signal processor's relay of information to the microcomputer and the microcomputer's or signal processor's instruction to the tuner are each a "reaction," as per the term's established meaning.

Yet another instance of support in the '81 case for the term "reaction" is found beginning at column 20, line 11. Thereafter, a method for delivering programming is described in which a viewer of a television program on cooking techniques uses a station of the present invention to accept an offer for delivery of a recipe. Halfway through the program, a program host makes an offer of delivery of a recipe. The offer prompts the viewing user to employ a local input at the station to convey a signal that indicates acceptance of the offer. With the acceptance, the recipe is delivered to the user station. The pressing of buttons by the user is a reaction in response to, elicited by and incited by a stimulus that is the program host's offer. Accordingly, a "reaction" is disclosed.

Regarding "resource":

Support is found in U.S. Pat. No. 4,694,490 at column 12, lines 46-47, and column 17 lines 10-24, and corresponds to the '87 Specification at pp. 324-390, and pp. 86-93, 162-193, 197-246, 272-278 and 312-324, respectively.

2. 35 U.S.C. § 102 Rejections

Anticipation requires the disclosure in a single prior art reference of each element of the claim under consideration. W.L. Gore & Associates v. Garlock, Inc., 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1990) (en banc), cert denied 500 U.S. 904 (1991). The prior art must disclose each element of the claimed invention arranged as in the claim.

Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co., 730 F.2d 1452,

221 USPQ 481 (Fed. Cir. 1984). The Office Action fails to make a proper rejection for anticipation as it fails to identify in the cited references each element of the claims in the present application.

As to paragraph 27, applicants respectfully traverse the 35 U.S.C. § 102(b) rejection of claims 2, 4-7, and 9 as being anticipated by Hedger et al..

Regarding claim 2, applicants submit that Hedger does not disclose or suggest the limitation in claim 2 of controlling a processor to process a prestored user input on the basis of downloadable processor instructions. Hedger discloses user input at a receiver station to select certain teletext pages. Hedger discloses downloading telesoftware along with transmission of teletext. However, Hedger does not disclose that the user input are stored. Hedger does not disclose that the user input is processed based on the received telesoftware.

Applicants submit that claim 2 is not anticipated by Hedger. As to claims 4 and 5, applicants submit that for at least the same reasons discussed regarding claim 2, Hedger does not disclose the limitations in claims 4 and 5. Applicants submit that claims 4 and 5 are patentable at least by virtue of their dependence from independent claim 2. Applicants respectfully request that these rejections be withdrawn.

Regarding claim 6, applicants submit that Hedger does not disclose or suggest the limitation in claim 6 of receiving at a transmitter station downloadable processor instructions which are effective at a receiver station to implement a scheme for locating, identifying, or assembling one or more control signals. Hedger discloses receiving telesoftware at a receiver station that has been transmitted from a transmitter station. Hedger does not disclose the transmitter station receiving the telesoftware. Further, Hedger discloses that the telesoftware at the receiver station will be used by the viewer. Hedger does not disclose the telesoftware being effective at a receiver station to implement a scheme for locating, identifying, or assembling one or more control

signals. The transmitted teletext pages in Hedger do not meet the limitation in claim 6 of one or more control signals. The teletext pages are simply transmitted to the receiver station to be viewed.

Further applicants submit that Hedger does not disclose or suggest the limitation in claim 6 of receiving one or more control signals at a transmitter station that operate to execute downloadable processor instructions. As stated, the teletext pages in Hedger are not control signals. Also, the teletext pages in Hedger do not operate to execute downloadable processor instructions.

Applicants submit that claim 6 is not anticipated by Hedger. As to claims 7 and 9, applicants submit that for at least the same reasons discussed regarding claim 6, Hedger does not disclose the limitations in claims 7 and 9. Applicants submit that claims 7 and 9 are patentable at least by virtue of their dependence from independent claim 6. Applicants respectfully request that these rejections be withdrawn.

As to paragraph 28, applicants respectfully traverse the 35 U.S.C. § 102(e) rejection of claims 10 as being anticipated by Pargee, Jr..

Applicants submit that Pargee does not disclose or suggest the limitation in claim 10 of providing data of interest to a receiver station from a remote data source, where the data of interest is used in generating at the receiver station user specific programming. Pargee discloses transmission of a burst of still picture images to users whom have selected some of the images. The users store all of the received images, and then can display and view those that the particular user had selected for transmission. Pargee does not disclose or suggest that the images selected by the user are used in generating at the receiver station user specific programming. The images selected in Pargee are stored, and then later viewed. The images in Pargee are not used to generate programming.

Further applicants submit that Pargee does not disclose or suggest the limitation in claim 10 of generating a user specific display or output by processing a stored information signal on the basis of an instruct signal which is received at the receiver station following receipt of a datum and is effective at the receiver station to implement a scheme for locating, identifying, or assembling a control signal. The still images that are displayed in Pargee, are not displayed on the basis of an instruct signal which is received at the receiver station and is effective at the receiver station to implement a scheme for locating, identifying, or assembling a control signal. The images in Pargee are displayed at any time simply by selection by the viewer. Further, Pargee does not disclose or suggest assembling a control signal.

Applicants submit that claim 10 is not anticipated by Pargee. Applicants respectfully request that this rejection be withdrawn.

As to paragraph 29, applicants respectfully traverse the 35 U.S.C. § 102(b) rejection of claims 2-9, 11-14, 29-33 and 45-49 as being anticipated by Zaboklicki.

Regarding claim 2, applicants submit that Zaboklicki does not disclose or suggest the limitation in claim 2 of controlling a processor to process a prestored user input on the basis of downloadable processor instructions extracted from an information transmission. Zaboklicki discloses receiving input from a subscriber at a receiver station where the subscriber's input determines the data that is subsequently sent to the subscriber in accordance with his input. Zaboklicki does not disclose that the subscriber's input is prestored. Zaboklicki teaches that the subscriber's input is in response to what is viewed and therefore cannot be prestored.

Applicants submit that claim 2 is not anticipated by Zaboklicki. As to claims 3-5, applicants submit that for at least the same reasons discussed regarding claim 2, Zaboklicki does not disclose the limitations in claims 3-5. Applicants submit that claims

3-5 are patentable at least by virtue of their dependence from independent claim 2.

Applicants respectfully request that these rejections be withdrawn.

Regarding claim 6, applicants submit that Zaboklicki does not disclose or suggest the limitation in claim 6 of receiving at a transmitter station downloadable processor instructions which are effective at a receiver station to implement a scheme for locating, identifying, or assembling one or more control signals. Zaboklicki discloses receiving telesoftware at a receiver station. Zaboklicki does not disclose receiving telesoftware or downloadable processor instructions at a transmitter station. Further, Zaboklicki does not disclose that the telesoftware that is received is effective at a receiver station to implement a scheme for locating, identifying, or assembling one or more control signals.

Applicants submit that claim 6 is not anticipated by Zaboklicki. As to claims 7-9, applicants submit that for at least the same reasons discussed regarding claim 6, Zaboklicki does not disclose the limitations in claims 7-9. Applicants submit that claims 7-9 are patentable at least by virtue of their dependence from independent claim 6. Applicants respectfully request that these rejections be withdrawn.

Regarding claim 11, applicants submit that Zaboklicki does not disclose or suggest the limitation in claim 11 of receiving at a subscriber station information that designates an instruct signal to process or an output to deliver in consequence of a subscriber's input. Zaboklicki discloses receiving input from a subscriber at a receiver station where the subscriber's input determines the data that is subsequently sent to the subscriber in accordance with his input. Zaboklicki does not disclose or suggest receiving information that designates an instruct signal to process.

Further, applicants submit that Zaboklicki does not disclose the limitation in claim 11 of processing an instruct signal which is effective to implement a scheme for locating, identifying, or assembling a control signal at a subscriber station. The output

46 of figure 4 in Zaboklicki, and referenced in the Office Action, does not meet the limitation of assembling a control signal at a subscriber station as recited in claim 11. The output 46 in Zaboklicki is the output to the telephone line which transfers the viewer's input to the remote station. Further, the multiplexer 38 in Zaboklicki which feeds the output 46 is not processing any signals. It simply passes one of many signals based on the control circuit 32.

Applicants submit that claim 11 is not anticipated by Zaboklicki. As to claims 12-14, applicants submit that for at least the same reasons discussed regarding claim 11, Zaboklicki does not disclose the limitations in claims 12-14. Applicants submit that claims 12-14 are patentable at least by virtue of their dependence from independent claim 11. Applicants respectfully request that these rejections be withdrawn.

Regarding claim 29, applicants submit that Zaboklicki does not disclose or suggest the limitation in claim 29 of an instruct signal being effective at a receiver station to implement a scheme for locating, identifying, or assembling one or more control signals. As stated previously, Zaboklicki discloses a subscriber input being used to determine what subsequent programming or data is sent to the subscriber. Zaboklicki does not disclose or suggest the limitations in claim 29 of an instruct signal, or assembling one or more control signals.

Applicants submit that claim 29 is not anticipated by Zaboklicki. As to claims 30-33, applicants submit that for at least the same reasons discussed regarding claim 29, Zaboklicki does not disclose the limitations in claims 30-33. Applicants submit that claims 30-33 are patentable at least by virtue of their dependence from independent claim 29. Applicants respectfully request that these rejections be withdrawn.

Regarding claim 39, applicants submit that Zaboklicki does not disclose or suggest the limitation in claim 39 of implementing a scheme for assembling a control signal on the basis of information received from a processor. As stated previously,

Zaboklicki discloses a subscriber input being used to determine what subsequent programming or data is sent to the subscriber. Zaboklicki does not disclose implementing a scheme for assembling a control signal.

Applicants submit that claim 39 is not anticipated by Zaboklicki. As to claims 40-42, applicants submit that for at least the same reasons discussed regarding claim 39, Zaboklicki does not disclose the limitations in claims 40-42. Applicants submit that claims 40-42 are patentable at least by virtue of their dependence from independent claim 39. Applicants respectfully request that these rejections be withdrawn.

Regarding claim 45, applicants submit that Zaboklicki does not disclose or suggest the limitation in claim 45 of receiving at a transmitter station an instruct signal and one or more control signals where the one or more control signals operate at a receiver station to communicate the instruct signal to a specific processor. The telesoftware in Zaboklicki, and referenced in the Office Action does not meet the limitation in claim 45 of an instruct signal. Further, the headers of the teletext pages in Zaboklicki, and referenced in the Office Action, do not meet the limitation in claim 45 of one or more control signals. Applicants also submit that Zaboklicki does not disclose that the headers of the teletext pages are received at a transmitter station.

Applicants submit that claim 45 is not anticipated by Zaboklicki. As to claims 46-49, applicants submit that for at least the same reasons discussed regarding claim 45, Zaboklicki does not disclose the limitations in claims 46-49. Applicants submit that claims 46-49 are patentable at least by virtue of their dependence from independent claim 45. Applicants respectfully request that these rejections be withdrawn.

As to paragraph 30, applicants respectfully traverse the 35 U.S.C. § 102(b) rejection of claims 15 and 16 as being anticipated by Block et al..

Regarding claim 15, applicants submit that Block does not disclose or suggest the limitation in claim 15 of identifying a resource to be processed to assemble a control

signal or a control signal which is effective to implement a scheme for assembling. Block discloses a method for determining which television programs are actually viewed by a subscriber at a receiver station to provide billing information at a remote location as to programs actually viewed by the subscriber. Block does not disclose assembling a control signal. Block does not disclose a control signal which is effective to implement a scheme for assembling.

Applicants submit that claim 15 is not anticipated by Block. As to claim 16, applicants submit that for at least the same reasons discussed regarding claim 15, Block does not disclose the limitations in claim 16. Applicants submit that claim 16 is patentable at least by virtue of its dependence from independent claim 15. Applicants respectfully request that these rejections be withdrawn.

As to paragraph 31, applicants respectfully traverse the 35 U.S.C. § 102(b) rejection of claims 17 as being anticipated by Breeze.

Applicants submit that Breeze does not disclose or suggest the limitation in claim 17 of receiving receiver identification signals that identify specific signal content for at least one of a plurality of concurrent broadcast or cablecast signal transmissions. The channel identification signals disclosed in Breeze do not meet this limitation in claim 17. The channel identification signals disclosed in Breeze do not identify specific signal content. The channel identification signals disclosed in Breeze merely identify the channel of the transmission, not the content of the transmission.

Applicants submit that claim 17 is not anticipated by Breeze. Applicants respectfully request that this rejection be withdrawn.

As to paragraph 32, applicants respectfully traverse the 35 U.S.C. § 102(b) rejection of claims 39 and 40 as being anticipated by Zawels et al..

Applicants submit that Zawels does not disclose or suggest the limitation in claim 39 of implementing a scheme for locating, identifying, or assembling a control

signal on the basis of information received from a processor. Zawels discloses teaching a multiplicity of students located remotely where each student can respond to questions that appear to him on his output means. Zawels does not disclose or suggest implementing a scheme for assembling a control signal on the basis of information received from a processor.

Applicants submit that claim 39 is not anticipated by Zawels. As to claim 40, applicants submit that for at least the same reasons discussed regarding claim 39, Zawels does not disclose the limitations in claim 40. Applicants submit that claim 40 is patentable at least by virtue of its dependence from independent claim 39. Applicants respectfully request that these rejections be withdrawn.

As to paragraph 33, applicants respectfully traverse the 35 U.S.C. § 102(b) rejection of claims 43 and 44 as being anticipated by Summers.

Regarding claim 43, applicants submit that Summers does not disclose or suggest the limitation in claim 43 of an information transmission including an instruct signal which is effective to implement a scheme for locating, identifying, or assembling a control signal. Summers discloses transmitting and utilizing supplemental data by modifying a video signal from a television camera to include a supplemental data signal that is sensed at the receiving station and utilized. Summers does not disclose or suggest an instruct signal which is effective to implement a scheme. Summers does not disclose or suggest assembling a control signal.

Applicants submit that claim 43 is not anticipated by Summers. As to claim 44, applicants submit that for at least the same reasons discussed regarding claim 43, Summers does not disclose the limitations in claim 44. Applicants submit that claim 44 is patentable at least by virtue of its dependence from independent claim 43. Applicants respectfully request that these rejections be withdrawn.

3. 35 U.S.C. § 103 Rejections

As to the 35 U.S.C. § 103 rejections for obviousness, the applicants traverse these rejections as being based on impermissible hindsight. That is, the Office Action's rejection under 35 U.S.C. § 103 is merely the teachings of applicants claimed invention against the applicants, a practice repeatedly held to violate obviousness requirements under §103. There must be a reason or suggestion in the art for combining the references, other than the knowledge obtained from applicants' disclosure. In re Dow Chemical, 5 USPQ2d 1529, 1532 (Fed. Cir. 1988) (citing Interconnect Planning Corporation v. Feil, 227 USPQ 543, 551 (Fed. Cir. 1985)), ACS Hospital Systems, supra, at 932. The mere fact that the prior art could be so modified does not make the modification obvious unless the prior art itself suggests the desirability of the modification. In re Gordon, 221 USPQ 1125 (Fed. Cir. 1984). The Federal Circuit has, on numerous occasions made this point clear. For example, the court stated in ACS Hospital Systems, Inc. v. Montefiore Hospital, 221 USPQ 929 (Fed. Cir. 1984) that:

obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under § 103, teachings of references can be combined only if there is some suggestion or incentive to do so.

ACS Hospital Systems, at 932-33. Since the Office Action employs references that, arguendo, disclose disparate aspects of the present invention and does not employ references to show that the cited prior art itself suggests the plucking of one limitation from one reference and another limitation from another reference, accordingly the applicants assert that the Office Action fails to meet this burden of establishing a *prima facie* case for obviousness.

As to paragraph 35, applicants respectfully traverse the 35 U.S.C. § 103(a) rejection of claims 34-38 as being unpatentable over Zawels et al. (U.S. Pat. 3,606,688) in view of Zawels (DE Pat. 2,853,764).

Regarding claim 34, applicants submit that neither Zawels (U.S) or Zawels (DE), taken alone or in combination, disclose or suggest the limitation in claim 34 of receiving an instruction that has an effect at a user station to implement a scheme for locating, identifying, or assembling a control signal. Zawels (U.S.) discloses teaching a multiplicity of students located remotely where each student can respond to questions that appear to him on his output means. Zawels (DE) discloses transmission of an instruction program which is suitable for instruction using a communication device by means of television. Neither Zawels (U.S) or Zawels (DE), taken alone or in combination, disclose or suggest an instruction that has an effect at a user station to implement a scheme for locating, identifying, or assembling a control signal, nor would this limitation in claim 34 be obvious from the teachings of either Zawels (U.S) or Zawels (DE).

Applicants submit that the limitations in claim 34 are non-obvious from Zawels (U.S) or Zawels (DE) taken alone or in combination. As to claims 35-38, applicants submit that for at least the same reasons discussed regarding claim 34, neither Zawels (U.S) or Zawels (DE) taken alone or in combination disclose the limitations in claims 35-38. Applicants submit that claims 35-38 are patentable at least by virtue of their dependence from independent claim 34. Applicants respectfully request that these rejections be withdrawn.

C. Response To Rejection Based On MPEP Section 804 (II)(B)(2)

As to the Office Action's rejection of applicants' claim under a non-statutory non-obvious type of double patenting, applicants strongly traverse examiner's double patenting rejection on three separate grounds. First, the applied section, MPEP § 804 (II)(B)(2), defining non-statutory non-obvious double patenting, is predicated on an improper reading of case law, and, thus, the resultant rejection constitutes an ultra vires action by the PTO. Second, the PTO's present rejection based on MPEP section 804

(II)(B)(2) is no more than an application of the now discredited late claiming doctrine. Third, assuming arguendo that the non-statutory non-obvious double patenting rejection set forth in MPEP § 804 (II)(B)(2) is a proper reading of case law, and not in violation of the Administrative Procedure Act, this class of rejection does not apply to the factual situation of the present application. Applicants' arguments for each contention are addressed in applicants' reply brief for application 08/113,329 and are herein incorporated by reference.

1. The Claims in the Present Application are Distinct From the Claims in the Patents

The PTO fails to specifically identify all claims from cited Harvey patents that cover specific claims in the present application. Rather, the Office Action references "representative claims" from patents and the present application. The Office Action does not cite specific elements from claims in a patent covering specific elements in claims in the application. In fact, the Office Action acknowledges that the patent claims and application claims are directed to different elements, but states that this "does not prohibit this rejection if there is common or interrelated subject matter recited." The Office Action then references Schneller in support of this erroneous statement, not supported by Schneller.

The claims in the present application are distinct from the claims in the Harvey patents. As previously mentioned, the Office Action states that the independent and distinct standard was the main factor in the Schneller court's determination that the double patenting rejection should be affirmed. The Office Action has misinterpreted this phrase. This phrase means independent 'or' distinct. MPEP (6th ed.) § 802.01. The MPEP defines independent as meaning "that there is no disclosed relationship between the two or more subjects disclosed" and that they are not connected. The MPEP defines

the term distinct as meaning that "two or more subjects disclosed are related . . . but are capable of separate manufacture, use, or sale as claimed . . ." Two or more subjects cannot then be unrelated, independent, and also related, and thus distinct. Analyzing the PTO's cited representative claims referenced in the Office Action, the claims of the present application are clearly distinct from the claims in the patents and therefore the claims in the present application are patentable. Applicants respectfully request that these rejections be withdrawn.

III. CONCLUSION

In accordance with the foregoing it is respectfully submitted that all outstanding objections are rejections have been overcome and/or rendered moot. Further, that all pending claims patentably distinguish over the prior art, taken in any proper combination. Thus, there being no further outstanding objections or rejections, the application is submitted as being in a condition for allowance, which action is earnestly solicited.

If the Examiner has any remaining informalities to be addressed, it is believed that prosecution can be expedited by the Examiner contacting the undersigned attorney for telephone interview to discuss resolution of such informalities.

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Respectfully submitted,


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